

REMARKS

Claims 1-40 are pending.

Claims 1-40 were rejected.

Claims 1, 6-9, 14-17, 20, 21, 23, 27, 29, 32, 33, 36 and 38-40 are amended, herein. No new matter has been added

Request for Continued Examination - 35 U.S.C. § 132(b) & 37 CFR § 1.114

Applicant is filing herewith a Request for Continued Examination. Authorization to pay the examination fee is included with this response.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 1-40 under 35 U.S.C. § 103(a) over Baker, *et al.* (U.S. Patent 6,646,765), in view of Sasabe, *et al.* (U.S. Patent 3,928,719).

While Applicant does not agree with the rejection of claims 1-40, claims 1, 6-9, 14-17, 20, 21, 23, 27, 29, 32, 33, 36 and 38-40 are amended for grammatical purposes or to further clarify the claim language in order to expedite prosecution, and without prejudice with regards to pursuing the claims as previously presented or in other forms in a continuation or other application.

For example, claim1 is amended to recite an image apparatus, comprising:

- a scanner adapted to scan a first document;
- a memory adapted to store image data corresponding to said first document;
- a signal control device adapted to generate a notify signal in response to said image data being stored in said memory; and
- a switch control device adapted to receive a first signal to display said document on a display device, and further adapted so that said scanner has the capability to scan a next document substantially concurrently with a displaying of the first document, wherein the next document is not displayed unless the switch control device receives a second signal.

The Examiner suggests that the computer 14 of Barker discloses the signal control device of claim 1, and that a commands signal generated by the computer 14 discloses the notify signal of claim 1. As previously argued in Applicant's 10/23/2007 response, while the Brown reference cited by the Examiner does mention a system interface 44 that receives and exchanges

data and commands from a computer 14 (column 4, lines 35-37), it fails to teach or suggest a signal control device adapted to generate a notify signal in response to said image data being stored in said memory, as recited by claim 1. Applicant respectfully submits that the mere reference to a computer 14 and interface 44 fails to disclose the recited features of claim 1, and that interpreting the commands exchanged there between as disclosing a notify signal is an improper use of hindsight including reading Applicant's own claim features into the cited reference. Barker does not disclose a notify signal, nor why it would be advantageous to generate a notify signal.

The Examiner acknowledges on page 4, section 3 of the January 2, 2008 Office Action that Barker does not disclose the switch control device of claim 1, adapted to receive a first signal to display said document on a display device, and further adapted so that said scanner has the capability to scan a next document substantially concurrently with a displaying of the first document. The Examiner further acknowledges at page 3 line 10 that Sasabe does not disclose that a next document is scanned substantially concurrently with a displaying of the first document. Since, as acknowledged by the Examiner, neither Barker nor Sasabe alone or in combination disclose all the features of claim 1, Applicant respectfully submits that a rejection of claim 1 based on this combination is improper.

The Examiner appears to argue (page 3 lines 7-11 of the January 2, 2008 Office Action) that a television signal and/or an image feedback signal at column 5 lines 34-40 disclose the first and/or next documents of claim 1. Applicant respectfully submits that the television signal is not a scanned document. The television signal is not scanned by the device 81 of Sasabe, let alone a scanner, rather the television signal is intercepted by an antenna 95 and coupled to the switching circuit 106 by a tuner 96 (column 5, lines 34). According to Sasabe at column 5 lines 31-50, a reproduction of a television signal and an image feedback signal are displayed concurrently. Apart from the television signal not being a scanned document, Sasabe merely teaches that the two signals are displayed concurrently, not that the next document is scanned substantially concurrently with a displaying of the first document.

In rejecting claim 1, the Examiner further identifies the film 85 of Barker as disclosing the next document of claim 1, and an image obtained through the scanning of the film 85 as disclosing the first document (page 5 lines 8-11 of the January 2, 2008 Office Action). Applicant respectfully submits that interpreting the film 85 as both a first document and a next document

would be contrary to general rules of claim construction that two claim elements are to be construed as separate or different elements. Additionally, Applicant submits that the Examiner's identification of what elements in Baker disclose the first and next documents recited by claim 1 is unclear, in view of the varying references to film, images of film, television signals and image feedback signals at various points in the grounds for rejection.

The Examiner appears to argue, at page 3 line 9 of the January 2, 2008 Office Action, that because Sasabe teaches that two signals are displayed concurrently, that this somehow discloses that a next document is scanned substantially concurrently with a displaying of the first document, as recited by claim 1. The Applicant respectfully disagrees with this conclusion. Claim 1 does not recite that two signals are displayed concurrently. However to expedite prosecution, claim 1 is amended to clarify that the next document is not displayed unless the switch control device receives a second signal. In contrast, Sasabe discloses that the image of the film 85 is displayed on the device 81 while it is being scanned.

Claim 1 is believed to be allowable at least for the reasons stated above. Claims 2-8, 38 and 39 are allowable as depending on claim 1 and for the further novel features recited therein. Claims 6-8, 38 and 39 were rejected on the basis that Barker discloses an interface panel 26 that displays "certain textual messages". Applicant respectfully submits that the mere reference to an interface panel that displays textual messages fails to disclose the recited features of claims 6-8, 38 and 39, and that interpreting the commands exchanged there between as disclosing a notify signal or a scanning signal is an improper use of hindsight including reading Applicant's own claim features into the cited reference. For example, claim 38 recites wherein the signal control device is further adapted to determine a scanning status of said next document being scanned, said scanning status capable of being displayed on said display device together with said first document. In contrast, Barker does not disclose that the interface panel 26 is capable of displaying a document, let alone a scanning signal.

If the Examiner is making an inherency argument in the rejection of claims 6-8, 38 and 39, Applicant respectfully reminds the Examiner that according to MPEP 2112 (IV), to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is

not sufficient. Applicant respectfully asserts that the mere presence of an interface pane that displays textual messages fails to make the features of the rejected claims necessarily present in Barker.

Accordingly, withdrawal of the rejection of claims 1-8, 38 and 39 is respectfully requested.

Claim 9 recites, in part, an image scanning system, comprising:

a display switch adapted to receive the notify signal and to display a notification of availability of said first document on a display device; and
a switch control device adapted to receive a starting signal to display said first document on said display device, and further adapted to notify said transmission device to transmit a second document to be scanned, the display device adapted to display said first document while said second document is being scanned, wherein said signal control device is further adapted to produce a scanning signal corresponding to a scanning status of said second document.

In rejecting claim 9, the Examiner states at page 8 line 3-5 of the January 2, 2008 Office Action, that the computer 14 has a function of notifying a user if the document is stored in memory 40. Applicant respectfully submits that this assertion is not supported by Barker, nor has the Examiner identified with particularity where in Barker this features is alleged to be disclosed. Neither of the references provided by the Examiner to Figure 1 or Figure 2 of Barker indicate where the computer 14 includes the functionality alleged by the Examiner, or more particularly as recited by claim 9. Rather Figures 1 and 2 of Barker are simple diagrammatic representations of a generic computer system.

Whereas the Examiner acknowledges that Barker fails to disclose a switch control device or a signal control device adapted to produce a scanning signal corresponding to a scanning status of a document, the Examiner instead references Sasabe as disclosing these features. However, Applicant respectfully submits that the Examiner has failed to identify with particularity where in Sasabe the signal control device and scanning signal are disclosed. The mere reference to a display 81 and film 85 of Figure 8 is insufficient to disclose to one skilled in the art the features of a signal control device adapted to produce a scanning signal. Applicant again respectfully points the Examiner to MPEP 2112 (IV) if the Examiner is relying on inherency in rejecting claim 9, and refers to the above arguments made for claims 6-8, 38 and 39.

Claim 9 is believed to be allowable at least for the reasons stated above. Claims 10-14 are allowable as depending on claim 1 and for the further novel features recited therein. Accordingly, withdrawal of the rejection of claims 9-14 is respectfully requested.

Claim 15 recites, in part, a scanning method, comprising:

scanning a next document substantially concurrently with the displaying of said first document, wherein said next document is not displayed while it is being scanned; and
displaying a notification of availability when said next document is available to be displayed.

Neither Barker nor Sasabe, alone or in combination, disclose these features. The Examiner acknowledges that Barker fails to disclose scanning a next document substantially concurrently with the displaying of said first document. As previously argued with respect to claim 1, Sasabe also fails to disclose these features. In addition, both references fail to disclose the further novel features wherein said next document is not displayed while it is being scanned; and displaying a notification of availability when said next document is available to be displayed. In contrast, Sasabe discloses that the scanned film 85 is displayed on the device 81 while it is being scanned (column 1 lines 59-68; column 5 lines 20-26, column 6 lines 4-7, among others).

Claim 15 is believed to be allowable at least for the reasons stated above. Claims 16-20 are allowable as depending on claim 15 and for the further novel features recited therein. Accordingly, withdrawal of the rejection of claims 15-20 is respectfully requested.

Claims 21-40 are believed to be allowable for the same or similar reasons as provided above with respect to claims 1-20, and the withdrawal of the rejection of claims 21-40 is also respectfully requested.

Any statements made by Examiner that are not addressed by Applicant do not necessarily constitute agreement by the Applicant. In some cases Applicant may have amended or argued the allowability of independent claims thereby obviating grounds for rejection of the dependent claims.

Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1-40 of the application as amended is requested. The examiner is encouraged to telephone the undersigned at (503) 224-2170 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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A handwritten signature in cursive script, reading "Bryan Kirkpatrick".

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